

U.S. Patent Application Serial No. 10/020,947
Response dated September 15, 2003
Reply to OA of **June 27, 2003**

REMARKS

Claims 1-4 are pending in this application. No amendment has been made herein.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindman et al. (U.S. Patent No. 5,974,655). (Office action paragraph no. 2)

Applicants note that the Examiner has apparently neglected to list this reference on the PTO-892 form. Applicants respectfully request that the reference be so listed to indicate that it is of record in this application.

The rejection of claims 1-4 is respectfully traversed.

Lindman et al. discloses a method of mounting a loudspeaker. The Examiner cites Lindman's use of adhesive annulus (flat ring) 3 as corresponding to the double coated pressure sensitive adhesive sheet of claim 1. Lindman discloses that this is comprised of elastic double-adhesive material (column 2, lines 1-3) and briefly further discusses this in column 2, lines 20-22 and 26-31. However, the reference gives no details on how to make or obtain the adhesive annulus.

The Examiner acknowledges that Lindman does not disclose the recited limitation in claim 1 on the maximum of loss tangent, but indicates that this would be inherent because "the scope of [Lindman's] invention is essentially the same as the instantly claimed invention."

In traversing the rejection, Applicants note that with regard to inherency, MPEP 2112 states, in part:

"The fact that a certain result or characteristic may occur or be present in the prior art is not

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sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) ..."

Applicants first note that Lindman et al. does not disclose **any** performance limitations on the adhesive annulus 3. In fact, column 2, line 26, states: "When the tape used is **more or less elastic**, ...," and column 2, line 29, states: "The use of **hard and non-elastic** material is also conceivable," (emphasis added). Clearly, the elasticity is **not important** in Lindman et al. Moreover, the reference discloses nothing about what kind of adhesive tape is used as adhesive annulus 3.

Applicants submit that the Examiner has given no basis in fact and/or technical reasoning that the limitation of claim 1 is necessarily inherent in commonly found double-sided adhesive tape or necessarily flows from the teachings of Lindman et al. Applicants submit that this limitation is not inherent. Similarly, the further limitation of claim 2 on the maximum of the loss tangent is **not** inherent in the teachings of Lindman et al.

Applicants also submit that, given that the parameter of maximum of loss tangent is not mentioned at all in Lindman et al., and that elasticity of annulus 3 is not even important in Lindman et al., there can be no suggestion or motivation in the reference for any values of this parameter.

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In addition to the above remarks, Applicants further submit that Lindman et al. does not appear to have **enabled** an adhesive layer having the limitations of claim 1 or claim 2. If Lindman et al. does not enable these limitations, Lindman et al. cannot anticipate claims 1 and 2.

Additionally, Applicants note that the Examiner has not addressed the limitation of a “portable telephone” in claims 3 and 4. As noted above, Lindman et al. only discloses mounting a loudspeaker in a telephone apparatus. Applicants submit that Lindman et al. does not discuss “portable telephones.”

Reconsideration and withdrawal of the rejection of claims 1-4 is therefore respectfully requested.

Claims 1-4 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP2000-106596 (Abstract). (Office action paragraph no. 4)

The rejection of claims 1-4 is respectfully traversed.

JP’596 discloses a submersion discrimination seal unit 10 adhered to a case of a portable telephone by using double-coated tape 11. The Examiner has taken the double-coated tape 11 as corresponding to the recited adhesive sheet of claim 1. However, there is no disclosure in the English abstract of JP’596 regarding maximum of loss tangent characteristics of the adhesive, or any

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characteristics that appear to be related to this parameter.

The Examiner has again stated that the claimed characteristic of maximum of loss tangent would be inherent. In response, Applicants submit that the Examiner has presented no “basis in fact and/or technical reasoning to support the determination” that the recited limitation on maximum of loss tangent would be inherent in the adhesive of the double-coated tape in JP’596.

In addition, as with Lindman et al, Applicants submit that JP’596 has not **enabled** the limitations on the adhesive sheet of claim 1 or claim 2.

Moreover, Applicants note that the Examiner’s stated motivation for optimizing the maximum of loss tangent parameter in JP’596 is “to keep the integrity of the mounted parts in a portable phone firmly attached.” However, the problem that is solved in JP’596 is “to improve a mounting job efficiency and to allow the user to easily discriminate occurrence of submersion.” In particular, this involves the behavior of the line 14a printed with water soluble ink opposite to the double-coated tape **13 when water soaks into the portable telephone set**. Affixing electronic parts does not appear to be the focus of JP’596, and in particular the detection of water soaking into the telephone would not appear to be related at all to the value of maximum of loss tangent for the double-coated tape.

Reconsideration of the rejection is therefore respectfully requested.

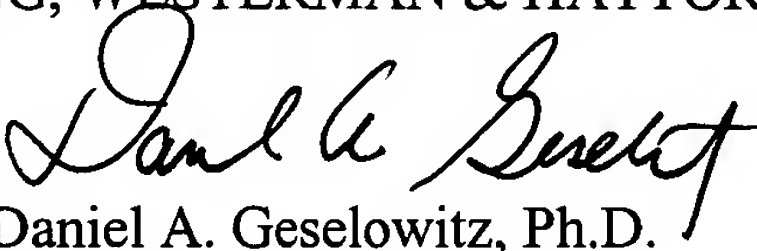
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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